



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Dale Malik

Serial No.: 09/287,023 Art Unit: 2743

Filed: April 6, 1999 Examiner: D. Nguyen

For: **METHODS AND SYSTEMS FOR USING THE PUBLIC SWITCHED TELEPHONE NETWORK TO CONDUCT A TRANSACTION BETWEEN CUSTOMER ACCOUNTS**

Assistant Director for Patents  
Washington, DC 20231

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**RESPONSE TO FIRST OFFICIAL ACTION**

Sir:

The Office Action mailed on July 18, 2000 rejects all of the claims (Claims 1-34) under 35 U.S.C. § 103(a) as allegedly obvious over *Morrill, Jr.*, United States Patent No. 5,991,749 (*Morrill, Jr.*). The rejections are respectfully traversed.

The Office Action is insufficient in that most of the rejections are unsupported. Particularly, the Office Action fails to directly address all but one (Claim 1) of the independent claims and fails to address many of the dependent claims. For example, the Office Action states: "Consider claims 1-3, 8-10, 12-13, 18-21, 26-29, 34." Office Action, page 2, paragraph 2. But the remainder of that paragraph merely refers to portions of Claim 1. No other claims are addressed. Thus, the rejections of the other claims, Claims 2-3, 8-10, 12-13, 18-21, 26-29, 34, are unsupported at least because these claims are not addressed in the Office Action.

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CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this correspondence, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on this 18 day of January 2001 with sufficient postage as first-class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Dale Malik

Moreover, the Office Action's rejection of Claim 1 is inapplicable to the other claims of the application, and in particular, inapplicable to the other independent claims. A review of the other independent claims demonstrates that their scope is different from that of Claim 1. The rejection of Claim 1 as set out in the Office Action does not apply to the other independent claims.

Further, the other independent claims (Claims 10, 18, 26, and 34) of the group of "unaddressed claims" have dependent claims. Some of these dependent claims (Claims 11, 14-17, 22-25, and 30-33) are rejected in the Office Action for alleged obviousness over *Morrill, Jr.* But the rejections of these dependent claims are erroneous. The rejections are erroneous at least because the independent claims (Claims 10, 18, 26, and 34) upon which these claims depend are not addressed in the Office Action. Thus, the rejections of these dependent claims also are insufficiently supported.

Moreover, the rejection of Claim 1 is erroneous. The stated reasons for the rejection of Claim 1 ignore limitations set forth in that claim. A review of the actions of Claim 1 demonstrates that the statement in the Office Action that "[a]ll other limitations of claim 1 are met by Morrill teachings...." is erroneous. *Morrill, Jr.* describes subject matter limited to wireless telephony and a "[c]ommunication [that] takes place between the cellular phone and the mobile telephone service provider's cell antenna and thence via land line to a CPU." *Morrill, Jr.*, col. 2, lines 29-31. In contrast, Claim 1 refers to actions that take place in a telecommunications system including a service switching point (SSP), a service control point (SCP), and an intelligent network element (INE). *Morrill, Jr.* does not teach nor suggest the use of elements such as included in the actions of Claim 1.

The Office Action also makes the mistake of finding that it would have been obvious to utilize the teachings of *Morrill, Jr.* in the Advanced Intelligent Network (AIN) to provide the subject matter of the pending claims. *Morrill, Jr.* does not teach nor suggest subject matter such that a telecommunications system other than a wireless system could be used for the conduct of financial transactions and other

activities. *Morrill, Jr.* only refers to a cellular phone that connects to a service provider's cell antenna and thence via land line to a central processing unit (CPU). See *Morrill, Jr.*, col. 2, lines 29-31. The CPU is described generally as handling the various transactions. There is no teaching nor suggestion in *Morrill, Jr.* as to how a CPU would carry out its necessary functions in a system other than that described in *Morrill, Jr.*

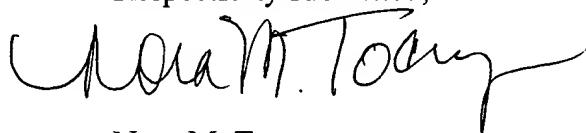
Further, *Morrill, Jr.*'s CPU does not compare to the billing system present as an element in some of the pending claims. The functions carried out by *Morrill, Jr.*'s CPU cannot be carried out by the billing system. For example, *Morrill, Jr.*'s CPU is directly involved with the customer and the transaction. "If the transaction involves a variable amount ...such as buying lunch or a souvenir from a street vendor, the CPU prompts the user to enter an amount, 'SEND' it, then prompts 'OK?' and the user presses "SEND" or clears and re-enters amount." *Morrill, Jr.*, col. 2, lines 45-50. The billing system in a telecommunications system such as covered by some of the pending claims does not interact with callers or telephones.

Further evidence that *Morrill, Jr.* does not teach nor suggest the claimed subject matter is that the methods of *Morrill, Jr.* take advantage of the mobility of cell phones to conduct the transactions or activities. In fact, all of *Morrill, Jr.*'s examples depend on the "mobility" of a cellular phone so as to allow the transactions in the examples to take place. In example 1, the transaction is a cash-equivalent purchase of a good or service such as a snack lunch from a vendor at an outdoor craft fair. In example 2, the transaction is a procedure for the entrance time recording and exit payment by a parking facility customer. In example 3, the transaction is the payment of transit fares such as a bus transit. Given the "mobility" associated with the customer in each of these transactions, *Morrill, Jr.* does not teach nor suggest the claimed subject matter.

CONCLUSION

The rejections have been traversed by the preceding demonstration that *Morrill, Jr.* fails to teach or suggest the subject matter of the claims of this application. The Examiner is invited to contact the undersigned at the Examiner's convenience should the Examiner believe it would facilitate prosecution of this application. The Examiner is thanked for his consideration of this application.

Respectfully submitted,



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